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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,623	12/06/2001	Malcolm R. Schuler	90065.161701	3753
7590	06/14/2006			
Thomas R. FitzGerald , Attorney Reynolds Arcade Bldg Suite 210 16 E Main Street Rochester, NY 14614-1803				EXAMINER MARKOFF, ALEXANDER
			ART UNIT 1746	PAPER NUMBER

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/008,623	SCHULER ET AL.
	Examiner	Art Unit
	Alexander Markoff	1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13, 14 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13, 14 and 27-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 13, 14 and 27-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicants amended the claims to recite a long and a short side of the transducer, moving the wafers parallel to the short side of the transducer and immersing the wafers such that the faces of the wafers are perpendicular to the short side of the transducer. Such limitations are not supported by the original disclosure. The original disclosure shows the transducer 30 as having its long side perpendicular to the surfaces of the wafers and parallel to the movement of the wafers. See Figs. 1 and 2 and the related description.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13, 14 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because it is not clear which side of the three-dimensional body of the transducer.

Response to Amendment

5. The amendment filed 3/30/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The applicants amended the claims to recite a long and a short side of the transducer, moving the wafers parallel to the short side of the transducer and immersing the wafers such that the faces of the wafers are perpendicular to the short side of the transducer. Such limitations are not supported by the original disclosure. The original disclosure shows the transducer 30 as having its long sides perpendicular to the surfaces of the wafers and parallel to the movement of the wafers. See Figs. 1 and 2 and the related description.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13, 14 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Stanasolovich et al (US Patent No 5,533,540).

Stanosolovich et al teach a method as claimed as conventional and known in the art. See at least Figure 1 and the related description.

8. Claims 13, 14 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer and Schwartzman (Shwartzman) (any one of US Patents No 3,893,869 and 4,118,649).

Mayer and Schwartzman (Shwartzman) teach a method as claimed. See at least column 1, lines 35-56 of '649 and Figures 1, 2 and column 4, lines 24-48 of '869.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 13-14 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (US Patent No 6,085,764) in view of Handbook of Semiconductor Wafer Cleaning Technology (HSWCT).

Kobayashi et al teaches a method as claimed except for generating of two sets of waves and the use of megasonic frequency. See entire document, especially Fig. 1 and Description of the Preferred Embodiment. The movement of the wafers in Kobayashi et al is the same as the movement of the wafers shown on Figs. 1 and 2 of the instant application.

Kobayashi et al teach the use of ultrasonic cavitation for cleaning.

The HSWCT teaches (page 141) that ultrasonic cavitation can cause a surface damage. The document recommends the use of megasonic waves produced by arrays of megasonic transducers to avoid the surface damage.

It would have been obvious to an ordinary artisan at the time the invention was made to use an array of megasonic transducers instead of the ultrasonic vibrator 12 in the method of Kobayashi et al in order to prevent damage from ultrasonic cavitation with reasonable expectation of success because the HSWCT recommends that.

Response to Arguments

13. Applicant's arguments filed 3/30/06 have been fully considered but they are not persuasive.

The applicants amended the claims to recite a long and a short side of the transducer, moving the wafers parallel to the short side of the transducer and immersing the wafers such that the faces of the wafers are perpendicular to the short side of the transducer.

The applicants argue that the prior art does not teach such limitations and that the application is in conditions for allowance.

The examiner disagrees. First, the referenced limitations are not supported by the original disclosure. Second, the referenced limitations made the claims indefinite. Third, the claims are still anticipated and/or obvious over the prior art.

It is noted that since the claims do not specify what is referenced as a short side of a three-dimensional body of the transducer any three-dimensional transducer of the applied prior art would have at least one side, which would meet the claimed limitations.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alexander Markoff
Primary Examiner
Art Unit 1746

AM

ALEXANDER MARKOFF
PRIMARY EXAMINER